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In re Application of	:	
FARMER et al.	:	
U.S. Application No. 09/509,159	:	DECISION ON PETITION
PCT No.: PCT/US98/07307	:	UNDER 37 CFR 1.137(b)
Int. Filing Date: 10 April 1998	:	AND 37 CFR 1.47(a)
Priority Date: 18 April 1997	:	
Attorney Docket No. 19374-501	:	
For: TOPICAL USE OF PROBIOTIC BACILLUS	:	
SPORES TO PREVENT OR CONTROL		
MICROBIAL INFECTIONS		

This is a decision on applicants' "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER CFR 1.137(b)" and the "PETITION UNDER 37 CFR 1.47(a)" filed 22 March 2000 in the above-captioned application. The petition fee under 37 CFR 1.17(m) and 37 CFR 1.17(i) have been submitted.

**BACKGROUND**

On 10 April 1998, applicant filed international application PCT/US98/07307 which claimed a priority date of 18 April 1997 and which designated the United States. A Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 18 October 1999.

On 22 March 2000, applicant filed a transmittal letter requesting entry into the national stage in the United States, which was accompanied, inter alia, by the basic national fee; a copy of the international application; a declaration executed by Sean Farmer; a small entity statement; a petition under 37 CFR 1.137(b) and the appropriate petition fee; and a petition under 37 CFR 1.47(a) and the appropriate petition fee.

**DISCUSSION**

**A. Petition Under 37 CFR 1.137(b)**

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until

the filing of a grantable petition was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

With regard to Item (1), the proper response was the payment of the basic national fee of \$345.00. Since all claims did not satisfy PCT Article 33(1)-(4), Deposit Account No. 50-0311 will charged an additional \$297.00, as authorized in the transmittal letter.

As to Item (2), the appropriate petition fee of \$605.00 as required by 37 CFR 1.17(m) was submitted.

With regard to Item (3), applicant's statement that "entire delay in filing the 35 U.S.C. 371(c) requirement from their due date until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

As to Item (4), the terminal disclaimer is not required since this application was filed after 08 June 1995.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate.

#### B. Petition under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by (a) the fee under 37 CFR 1.17(h), (b) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (c) a statement of the last known address of the missing inventor, and (d) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Items (a) and (c) have been satisfied.

Regarding item (b) above, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where inability to find or reach a non-signing inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a non-signing inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Such a petition will be dismissed as inappropriate.

Applicant has not satisfied Item (b). The statement by the petitioner that "I, Sean Farmer, do hereby state that I have made a diligent attempt to contact Robert J. Mikhail, a co-inventor of the above-referenced application . . . These attempts to contact Mr. Mikhail have been made via U.S. mail and electronic mail (E-mail) to his last known address" is insufficient, standing alone, to establish that inventor Robert J. Mikhail could not be found or reached after diligent effort. Applicants have not provided copies of any documentary evidence that support the finding that inventor, Robert J. Mikhail, could not be found

or reached after diligent effort. A copy of any correspondences mailed and details regarding any telephone calls made or attempted and/or electronic mail communications to secure the signature of inventor Robert J. Mikhail should be addressed in any verified statements provided. Was a complete copy of the application papers (specification, including claims, drawings, and oath or declaration) mailed to the last known address of the non-signing inventor? Were the documents eventually returned, or forwarded to a new address by the postal service? A copy of any envelopes returned as undelivered by the postal service should be provided. The efforts that were made, if any, to secure the signature of Robert J. Mikhail during the filing of the priority document and entry into the national stage in the United States should be specifically addressed. In sum, the statement of the petitioner does not show that a reasonable effort was made to secure the signature of the non-signing inventor. Accordingly, it is inappropriate, to accord the national stage application status under 37 CFR 1.47(a).

Regarding item (d), an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor has not been furnished as required.

### CONCLUSION

The petition under 37 CFR 1.137(b) is **GRANTED**.

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the Legal Affairs Division of the PCT Legal Office.



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